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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,746	10/02/2003	Kenneth Salwitz	13910-012001/2003P00027US	6621
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FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER KARDOS, NEIL R	
			ART UNIT 3623	PAPER NUMBER
			NOTIFICATION DATE 11/16/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary	Application No. 10/678,746	Applicant(s) SALWITZ ET AL.	
	Examiner Neil R. Kardos	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-10,19-24 and 26-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-10,19-24 and 26-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is a **FINAL** Office Action on the merits in response to communications filed on July 27, 2009. Currently, claims 1-6, 8-10, 19-24, and 26-28 are pending and have been examined.

Response to Arguments

Applicant's arguments filed on July 27, 2009 have been fully considered but they are not persuasive. Applicant argues that the method claims (claims 1-6 and 8-10) are directed to patent-eligible subject matter. Examiner respectfully disagrees. Applicant argues that the claims are tied to a statutory class and transform underlying subject matter. However, to qualify as a statutory process under § 101, the claim should positively recite the machine to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state). Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. *See Bilski*, 545 F.3d at 957; *Benson*, 409 U.S. at 71-72. Thus, incidental physical limitations such as insignificant extra-solution activity and field of use limitations are not sufficient to convert an otherwise ineligible process into a statutory one.

Here, the claimed process fails to meet the above requirements for patentability under § 101 because it is not tied to a particular machine and does not transform an article to a different state.

The sole recitation of a machine occurs in the preamble of the claim. Such nominal recitation of structure is insufficient to qualify the claimed invention for patent-eligibility under § 101. A preamble is generally not accorded any patentable weight where it merely recites the

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purpose of a process or the intended use of a structure and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976); *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Furthermore, a preamble generally is not limiting when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention. See MPEP 2111.02. Here, the claim body is capable of standing alone and does not require the elements recited in the preamble for completeness. Thus, the recitation of a processing device in the preamble does not sufficiently tie the claim to a particular machine as required for patentability under § 101.

The machine-or-transformation test requires the transformation of an "article" into a different state or thing. *In re Bilski*, 545 F.3d 943, 962 (Fed. Cir. 2008). Here, the claimed "objects" are not an "article" within the purview of the transformation prong of the machine-or-transformation test. Thus, the claim fails this prong of the test and is not patentable under § 101. The mere transformation of data is insufficient to make the claimed invention patent-eligible under § 101.

The remainder of Applicant's arguments are moot in view of the new grounds of rejection, below. The new grounds of rejection is necessitated by Applicant's amendments to the claims; thus, the finality of the present Office Action is proper.

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Claim Objections

Claims 1-6, 8-10, 19-24, and 26-28 are objected to because of the following informalities:

Claims 1 and 19: Claims 1 and 19 recite "the baseline objects." There is insufficient antecedent basis for this limitation in the claims. Examiner interprets the baseline objects as the claimed "first objects." For consistency and clarity, "baseline objects" should be changed to "first objects."

Claims 2-6, 8-10, 20-24, and 26-28: The dependent claims are objected to for failing to remedy the deficiencies of the claims from which they depend.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6 and 8-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1: Claim 1 is directed toward the statutory category of a process. In order for a claimed process to be patentable subject matter under 35 U.S.C. § 101, it must either: (1) be tied to a particular machine, or (2) transform a particular article to a different state or thing. *See in re Bilski*, 545 F.3d 943, 956 (Fed. Cir. 2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method/process is not patentable subject matter under § 101. Thus, to qualify as a statutory process under § 101, the claim should positively

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recite the machine to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state). Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. *See Bilski*, 545 F.3d at 957; *Benson*, 409 U.S. at 71-72. Thus, incidental physical limitations such as insignificant extra-solution activity and field of use limitations are not sufficient to convert an otherwise ineligible process into a statutory one.

Here, the claimed process fails to meet the above requirements for patentability under § 101 because it is not tied to a particular machine and does not transform an article to a different state.

The sole recitation of a machine occurs in the preamble of the claim. Such nominal recitation of structure is insufficient to qualify the claimed invention for patent-eligibility under § 101. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. *See In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976); *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Furthermore, a preamble generally is not limiting when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention. *See* MPEP 2111.02. Here, the claim body is capable of standing alone and does not require the elements recited in the preamble for completeness. Thus, the recitation of a processing device in the

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preamble does not sufficiently tie the claim to a particular machine as required for patentability under § 101.

The machine-or-transformation test requires the transformation of an "article" into a different state or thing. *In re Bilski*, 545 F.3d 943, 962 (Fed. Cir. 2008). Here, the claimed "objects" are not an "article" within the purview of the transformation prong of the machine-or-transformation test. Thus, the claim fails this prong of the test and is not patentable under § 101. The mere transformation of data is insufficient to make the claimed invention patent-eligible under § 101.

Claims 2-6 and 8-10: The dependent claims are rejected for failing to remedy the deficiencies of the claims from which they depend.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 and 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Wood (US 5,381,332).

Claim 1: Wood discloses a method performed on a processing device, comprising:

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- storing a simulation version of a project baseline, the simulation version comprising first objects that define elements of the project baseline (see column 10: lines 51-62, disclosing creating a project baseline; column 11: lines 35-40, disclosing storing the baseline; figure 9A: item 19; column 10: lines 40-50);
- copying the simulation version to create an operative version of the project baseline (see figure 9A: item 11, disclosing transferring the initial baseline from viewpoint to control; figure 10: items 1010 and 11, disclosing transferring the initial baseline; column 10: lines 40-63, disclosing transferring a baseline; column 21: lines 20-35);
- changing the simulation version by associating second objects with the baseline objects, the first objects being separate from the second objects and the first objects not changing when the simulation version is changed (see figure 9B: item 28, disclosing transferring revisions to the baseline from viewpoint to control; figure 10: items 1014 and 28, disclosing transferring revisions to the project baseline; column 11: lines 7-40, disclosing altering the baseline while maintaining the original version in an archive; column 21: lines 20-35);
- changing the operative version in connection with changes to the simulation version, the operative version comprising third objects that are versions of the first objects that are changed in accordance with the second objects (see sections cited above);
- updating a portion of the project baseline that succeeds a time at which the operative version is changed (see column 10: line 63 through column 11: line 6,

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disclosing updating the status of the baseline based on actual start and completion dates);

- obtaining, via the changed operative version, an earned value for a project that corresponds to the updated project baseline (see figure 6, disclosing earned value calculations; column 8: lines 3-13, disclosing calculating earned value; column 8: lines 60-68, disclosing calculating earned value via budgeted cost of work performed; column 15: line 19 through column 16: line 25, disclosing a module for calculating earned value; column 18: lines 8-62, disclosing calculating budgeted cost of work performed).

Claim 2: Wood discloses wherein the earned value is obtained based on an amount of work done on the project and a pre-assigned value for the project baseline (see figure 6, disclosing different earned value types with pre-assigned percentages; column 8: lines 60-68, disclosing calculating budgeted cost of work performed; column 18: lines 8-62, disclosing calculating budgeted cost of work performed based on a completion value or work accomplished).

Claim 3: Wood discloses wherein the amount of work done corresponds to a portion of the project that has been completed (see sections cited above; the reference discloses determining the budgeted cost of work performed).

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Claims 19-21: Claims 19-21 are substantially similar to claims 1-3 and are rejected under similar rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6, 8-10, 22-24, and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood in view of "Microsoft Project 1998 Support Course" ("MSP 1998").

Claim 4: Wood does not explicitly disclose the limitations of this claim. MSP 1998 discloses wherein the project baseline comprises a number of tasks (see at least table on page 6-18), each of the tasks having an assigned value (see at least pages 6-23 through 6-25; 6-28; 6-31 and 6-32); and wherein obtaining the earned value comprises: determining which of the tasks has been completed; and combining assigned values for completed tasks (see table on page 6-28).

Both Wood and MSP 1998 are related to project management. Wood specifically discloses adapting the teachings disclosed in the Wood reference to operate in Microsoft Project (see column 6: lines 4-30). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the references to incorporate the earned value techniques of MSP 1998 into the invention disclosed by Wood. This combination of known

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elements retains the functionality of the separate elements and produces a result that would be predictable to one of ordinary skill in the art.

Claim 5: Wood does not explicitly disclose augmenting the simulation version with a task, the task being defined by the second objects, wherein the third objects account for the task prior to obtaining the earned value. However, Wood does disclose augmenting the simulation version by altering the baseline (see figure 10: items 1014 and 28, disclosing transferring revisions to the project baseline; column 11: lines 7-40, disclosing altering the baseline while maintaining the original version in an archive; column 21: lines 20-35), and wherein the alterations are accounted for prior to obtaining the earned value (see *id.*). However, Wood does not disclose that the alteration is the addition of a task. MSP 1998 discloses tasks (see page 6-33; also note that Microsoft Project allows users to add tasks/projects and recalculate earned values). Furthermore, Examiner takes Official Notice that it was well-known in the art at the time the invention was made to add tasks to a project (e.g. Microsoft Project allows this). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to alter the project baseline of Wood by adding a task. This combination of known elements retains the functionality of the separate elements and produces a result that would be predictable to one of ordinary skill in the art.

Claim 6: Wood discloses wherein augmenting comprises adding second objects to the simulation version but keeping the second objects separate from the first objects (see at least column 11: lines 35-40, disclosing archiving the original baseline).

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Claim 8: Wood discloses wherein a portion of the operative version that precedes a time that the task is incorporated is unchanged (see column 10: line 63 through column 11: line 6, disclosing updating the status of the baseline based on actual start and completion dates).

Claim 9: Wood discloses wherein a portion of the operative version that succeeds a time that the task is incorporated is changed (see column 10: line 63 through column 11: line 6, disclosing updating the status of the baseline based on actual start and completion dates).

Claim 10: Wood and MSP 1998 do not explicitly disclose wherein the task is selected from among other tasks for mapping to the operative version. However, Examiner takes Official Notice that it was well-known in the art at the time the invention was made to use a selection mechanism to make decisions on a computer (e.g. a drop-down box). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select tasks for addition to the operative version disclosed by Wood. This combination of known elements retains the functionality of the separate elements and produces a result that would be predictable to one of ordinary skill in the art.

Claims 22-24 and 26-28: Claims 22-24 and 26-28 are substantially similar to claims 4-6 and 8-10 and are rejected under similar rationale.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Judy (2003/0229618), directed to project tracking and reporting.
- Kruey (US 6,978,281), directed to storing versions of project data.
- Fleming, Quentin W. and Joel M. Koppelman, "Earned Value Project Management: A Powerful Tool for Software Projects." Crosstalk: The Journal of Defense Software Engineering, 19-23 (July 1998).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. Kardos whose telephone number is (571) 270-3443. The examiner can normally be reached on Monday through Friday from 9 am to 5 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neil R. Kardos
Examiner
Art Unit 3623

/Neil R. Kardos/
Examiner, Art Unit 3623
/Jonathan G. Sterrett/
Primary Examiner, Art Unit 3623